

### **Remarks/Arguments**

Reconsideration of this application, as amended, is respectfully requested.

#### **I. Status of the Claims**

After entry of these amendments, claims 1-8 and 11-18 are pending. Claims 1-6 are amended. Claims 9 and 10 are canceled. New claim 18 is added.

Each of claims 1 to 6 are amended to overcome a formal rejection, to recite "or a pharmaceutically acceptable salt thereof."

Claim 1 is further amended at the request of the Examiner to recite that W and Z are divalent (i.e., alkylene or alkenylene).

Claim 1 is amended to delete that "an individual carbon atom in A and an individual carbon atom in B optionally bridge said ring."

Claim 1 is amended to recite that for the second fragment of Y, "the CH<sub>2</sub> moiety is bound to Z and the cyclopropyl moiety is bound to R<sup>1</sup>." Support for this amendment is found at Example 4, at pages 41-42 of the specification.

Claim 1 is amended to recite that for the third fragment of Y, C' and C'' are "each independently directly or indirectly bound to an R<sup>1</sup> phenyl ring." Support for this amendment is found at Example 31, at page 73 of the specification.

Claim 1 is also amended to recite that R<sup>4</sup> (within the definition of Z) may be hydrogen. Support for this amendment is found in the application as filed, in the definition of R<sup>4</sup> in original claim 1 and at page 6, line 7.

Claim 6 is amended to become dependent from claim 1.

Claim 6 is also amended to delete species not encompassed by original claim 1.

New claim 18 is added, to cover the species deleted from claim 1. Support for this amendment is found in original claim 6.

No new matter is added by these amendments.

#### **II. Restriction Requirement**

The Examiner requires restriction among Groups I-IX. As noted by the Examiner, the undersigned had provisionally elected the Group I claims (claims 1-7, 9 and 10, drawn to compounds of

formula I, Ia, Ib, Ic and compounds of claim 6, and pharmaceutical compositions thereof). Applicants now confirm the election of the Group I subject matter, without traverse.

### III. Claim Objections

The Examiner objects to claims 9 and 10 as being substantial duplicates of each other. Claims 9 and 10 are canceled, thereby obviating the objections. It is respectfully requested that the objections be withdrawn.

### IV. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-7, 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Examiner objects to the use of "and pharmaceutically acceptable salts thereof, and individual diastereomers thereof." As requested, each of claims 1 to 6 are amended to recite "or a pharmaceutically acceptable salt thereof, or diastereomer thereof."

The Examiner objects to the definition of "Y" in Figure I in claim 1. The Examiner states as follows:

The orientation of the second and third fragments is unclear. Is the cyclopropyl attached to Z or to R<sup>1</sup>? In the third fragment, it appears that C' and C'' are attached to the phenyl ring to form a bicyclic ring system. It is unclear what is meant by "directly or indirectly bound to R<sup>1</sup> . . . ."

In response, the Examiner is advised that for the second fragment, the methylene group is bound to Z and the cyclopropyl group is bound to R<sup>1</sup>, as shown in Example 4 (at pages 41-42 of the specification). For the third fragment, the Examiner is correct that C' and C'' are attached to a phenyl ring of R<sup>1</sup> (see Example 31, at page 73 of the specification). Claim 1 is amended to clarify the meaning of the claim.

The Examiner requests that the definitions of "Z" and "W" in claim 1 should reflect the divalent nature of these variables. Claim 1 is amended as requested by the Examiner.

The Examiner objects to the language of claim 1 that "an individual carbon atom in A and an individual carbon atom in B optionally bridge said ring" is unclear. Claim 1 is amended to delete the phrase cited by the Examiner.

The Examiner also objects to claim 6 on the grounds that it recites approximately 140 species. The Examiner states that "[t]his number of compounds cannot be considered a reasonable number," citing *In re Fressola*, 22 USPQ2d 1828. According to the Examiner, some of the compounds in claim 6 "may not be compounds of claims 1-5."

Applicants respectfully traverse this rejection, on the grounds of the amendments entered herein. All of the compounds of claim 6 as now presented are within the genus claimed in claim 1. In the

claim 6 species, W is either absent, -CH<sub>2</sub>- or -CH<sub>2</sub>CH<sub>2</sub>-; A and B are either absent or represent -CH<sub>2</sub>-, thereby permitting a 4, 5 or 6 membered cyclic ring (with optional halogen substitution); Z is absent, or is O, (C=O), S, SO<sub>2</sub>, NR<sup>4</sup>, C<sub>2-6</sub> alkenyl, a C<sub>1-6</sub> alkyl group which is optionally substituted with halogen, or is R<sup>5</sup> (wherein R<sup>5</sup> is alkyl) or OR<sup>5</sup> (wherein R<sup>5</sup> is hydrogen or alkyl).

Independent claim 18 is added, to cover species of the invention in which an alkyl chain substituted by hydroxyl is present at the Y position.

Further, claim 6 is amended to become dependent from claim 1.

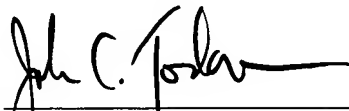
In view of the action taken and arguments made, it is believed that the indefiniteness rejections have been overcome. It is respectfully requested that the rejections be withdrawn.

**V. Conclusion**

In view of the foregoing, it is believed that claims 1-8 and 11-17 are not indefinite, and are now in condition for allowance.

Favorable action is earnestly solicited.

Respectfully submitted,

By 

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